

Attorney Docket No. AUS920000655US1
Serial No. 09/731,651
Response to Office Action dated July 13, 2005

II. REMARKS

A. Office Action Summary

The Examiner rejected claims 1-7, 9, 11-13, 15, 18-20, 22-24, 26-27, and 29 under 35 U.S.C. § 102¹ as being anticipated by U.S. Patent No. 6,490,601 (issued Dec. 3, 2002) [hereinafter "Markus"], rejected claims 8 and 16 under 35 U.S.C. § 103 as unpatentable over Markus in view of U.S. Patent No. 6,026,410² (issued Feb. 15, 2000) [hereinafter "Allen"], and rejected claims 28 and 30 under § 103 as unpatentable over Markus in view of U.S. Patent No. 6,065,048 (issued May 16, 2000) [hereinafter "Higley"].

B. Prior Art References

Before addressing the substance of the Examiner's action, the Applicant provides the following summary of the prior art in order to convey the Applicant's current understanding of the reference upon which the Examiner relies.

Markus is the only reference that the Examiner cites that is relevant to Applicant's independent claims. Markus discloses an apparatus and accompanying processes for filling in web-based forms. Markus, *supra*, at 6:39-40. In particular, Markus describes a server (the "privacy bank") that stores user data in "standard" merchant fields. *See, e.g., id.* at 7:1-10. In

¹ The Examiner cites § 102(b), but Markus does not appear to be a valid reference under this section since it issued well after the filing date of the present application. See 35 U.S.C.S. § 102(b) (LEXIS 2005); United States Patent & Trademark Office, *Manual of Patent Examining Procedure* § 706.02(a) (8th ed. Rev. 2 2004), http://www.uspto.gov/web/offices/pac/mpep/documents/0700_706_02_a.htm#sect706.02a [hereinafter "MPEP"]. In the interest of efficient prosecution, though, the Applicant assumes that the Examiner would make an equivalent rejection under § 102(e).

² As in the office action from the Examiner dated 5/6/2004, the Examiner cites U.S. Patent No. 6,026,761, indicating that it was filed 2/10/1997 and that the Applicant provided this reference. But inasmuch as this reference was not issued to Allen et al., was not filed on 2/10/1997, and the Applicant did not provide such a reference, the Applicant again assumes that that the Examiner intended to cite U.S. Patent No. 6,026,410, which was issued to Allen et al., which was filed on 2/10/1997, and which the Applicant *did* provide.

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general, a merchant provides a form, or forms, to the privacy bank provider. *Id.* at 7:15-20. The privacy bank provider then creates a "map" between the fields in the merchant's form and the privacy bank's fields. *Id.* at 7:18-21. The merchant also must indicate how the merchant intends to use the data associated with each field (the merchant's "privacy practices"). *Id.* at 14:30-50. The merchant inserts into the form an "external link" to the privacy bank, and then publishes the form on the merchant's website. *Id.* at 9:66-10:2. Similarly, a privacy bank user (a "consumer") provides personal data (such as a name and credit card number) to the privacy bank, *id.* at 7:1-10, and specifies privacy preferences, *id.* at 14:63-15:8. If the consumer subsequently downloads the form from the merchant's website, the consumer's browser identifies the external link and connects to the privacy bank. *Id.* at 10:4-6. The privacy bank server then constructs "a shippable code segment or profile," *id.* at 13:25-26, which is "formed from information in the privacy bank memory that will enable the form document to be filled out automatically," *id.* at 11:7-9. The shippable code segment is constructed by applying the map between the merchant's fields and the privacy bank fields to match the merchant's fields with the consumer's personal data stored in the privacy bank fields. *Id.* at 14:5-15. The privacy bank server also compares the merchant's privacy practices with the consumer's privacy preferences. *See, e.g., id.* at 15:20-40. If the merchant's privacy practices do not exactly conform to the consumer's privacy preferences, then the privacy bank server notifies the consumer, and may attempt to resolve the conflict with a real-time "negotiation" between the merchant and the consumer. *See id.* at 15:41-16:8. The shippable code segment is transferred to and "stored in the browser residing on the user's computer, and is executable upon a user trigger."³ *Id.* at 11:13-14. If the consumer

³ In prior correspondence, the Applicant described the process slightly different. Specifically, the Applicant stated that the privacy bank "reconstructs the merchant's form with the standardized fields, incorporates a JavaScript program into the form that includes instructions for merging the consumer's data with the standardized fields, and transmits the reconstructed form to the browser." (Correspondence from Applicant to Examiner of 8/6/2004, at 3

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subsequently activates the shippable code segment, typically by clicking an icon or a link in the form, then the shippable code segment enters the consumer's data into the fields in the form and displays the results in the consumer's browser. *Id.* at 11:10-62.

C. Examiner Interview Summary

The Applicant interviewed the Examiner by telephone on September 2, 2005.

1. Exhibits & Demonstrations

The Applicant did not present exhibits or conduct demonstrations.

2. Claims Discussed

Claims 1 was discussed.

3. Substance of Interview

The Applicant and the Examiner discussed the Applicant's claimed subject matter and the subject matter disclosed in U.S. Patent No. 6,490,601 (issued Dec. 3, 2002) [hereinafter "Markus"]. The Applicant first directed the Examiner's attention to the distinctions between the Applicant's use of the term "standard" and Markus's use of that term. In particular, the Applicant cited column 5, lines 2-5 in Markus, which clearly indicates that Markus equates the term "standard fields" with "pre-defined fields." The Applicant further pointed out that Markus (in the same cited passage) refers to the fields in the forms as "non-standard" fields. The Applicant emphasized to the Examiner that Markus's use of "standard" fields in a database and "non-standard" fields in the forms necessitated a "mapping" between the database fields and the form fields. The Applicant then directed the Examiner's attention to the Applicant's explicit

(citing Markus, *supra*, at 10:8-12, 8:24-27, 11:3-10)). Upon further review, the Applicant believes that this prior description was technically deficient, and has attempted to correct these deficiencies here.

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definition of a "standard" in the specification and the significant distinctions between this explicit definition and meaning imparted by Markus.

The Examiner indicated that the Applicant's arguments appeared persuasive, but also indicated that he was not in a position to reach any formal agreement during the interview and would need to review Markus further before taking any action. The Examiner also indicated that the Applicant might advance the prosecution of the claims if the Applicant would incorporate the Applicant's explicit definition of the term "standard" into the claims.

D. Reply to Claim Rejections

The Examiner's "new ground(s) of rejection" (see Correspondence from Examiner to Applicant of 7/13/2005, at 9) does not change the Applicant's position with respect to Markus. Contrary to the Examiner's conclusion, Markus does not teach all of the limitations in independent claims 1, 12, and 22. Among other things, Markus does not disclose the use of a form or a database that is compliant with a "standard," as that term is properly construed. This distinction and others are discussed more fully below.

1. The Applicant's Definition of "Standard" Controls

During patent examination, an applicant's claims must be "given their broadest reasonable interpretation *consistent with the specification*." United States Patent & Trademark Office, *Manual of Patent Examining Procedure* § 2111 (8th ed. Rev. 2 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)) (emphasis added) [hereinafter MPEP]. "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." MPEP § 2111 (citing *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999)).

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Moreover, “[a] fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art.” See MPEP § 2173.01. “Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.” MPEP § 2106 (citing *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999)).

The Applicant’s claimed invention requires “an electronic form having at least one field that is compliant with a *standard*.” U.S. Patent Application 09/731,651, claims 1, 12, & 22 (filed Dec. 7, 2000) (amended Aug. 6, 2004) (emphasis added) [hereinafter “Applicant’s Disclosure”]. The Applicant has clearly defined the term “standard” to mean “a protocol extension which specifies the fields which may be used in the forms *and* in the corresponding user database.” *Id.* at 5 (emphasis added). The Applicant nonetheless has amended each independent claim to include explicitly this defining terminology already presented in the descriptive text. Since the Applicant has provided an explicit definition for the term “standard,” that definition controls the interpretation of the term as it is used in the Applicant’s claims.

2. Markus Does Not Disclose a Form that is Compliant with a “Standard”

Markus does not disclose the use of a “standard,” as that term is defined by the Applicant. Markus does refer to “standard fields,” but as Markus uses that term, it refers merely to “pre-named fields” that are selected by a service provider for use in the database. See, e.g., Markus, *supra*, at 5:3-5. Markus clearly indicates that the merchant’s form consists of “non-standard”⁴ fields, which the service provider must “map” to the privacy bank provider’s pre-named fields.

⁴ Markus also refers to these fields as “legacy” fields. Markus, *supra*, at 14:9-15.

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Id.; see also *id.* at 14:9-15. Thus, the merchant's form, which is the form the consumer interacts with, is not required to conform to the privacy bank provider's pre-named fields. *Id.* Thus, Markus does not disclose a standard that "specifies the fields which may be used in the forms and in the corresponding user database." See Applicant's Disclosure, *supra*, at 5 (defining the term "standard") (emphasis added). Markus, then, cannot disclose a form that is compliant with such a standard, as claimed by the Applicant in claims 1, 12, and 22.

3. Markus Does Not Disclose a Database that is Compliant with a "Standard"

Since Markus does not disclose the use of a "standard," Markus cannot disclose "a database having at least one field that is compliant with the standard." See *id.*, amended claims 1, 12, and 22.

4. Markus Does Not Disclose Rules that Select One Field Value From Each Database Field Having a Plurality of Field Values

In addition to the distinctions already highlighted, the Applicant's claimed invention also includes "rules that select one field value from each compliant database field having a plurality of field values." *Id.* As noted above, the Markus method employs a set of rules for completing the fields in a form. See, e.g., Markus, *supra*, at 7:10-14 (referring to "privacy rules"). These rules, when compared with the merchant's privacy practices, determine which *fields* the shippable code segment automatically populates for the consumer. See, e.g., *id.* at 15:20-40. In contrast, the Applicant's claimed invention employs a set of rules that determine which *values* are selected from the database to populate each field. See Applicant's Disclosure, *supra*, at 11-12. Thus, Markus does not disclose this limitation of the Applicant's independent claims.

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5. Since Markus Does Not Disclose "Each and Every" Element Set Forth in the Independent Claims, Markus Cannot Anticipate the Applicant's Claimed Invention under 35 U.S.C. § 102

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). *See also* MPEP § 2131. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Clearly, Markus does not disclose "each and every" element set forth in independent claims 1, 12, and 22, much less in "as complete detail as is contained in the claim." Among other things, Markus does not disclose the use of a "standard," or the use of a form or a database that complies with such a standard. Moreover, Markus does not disclose a set of rules that select one field value from each database field having a plurality of values. Since Markus does not disclose these limitations in the independent claims, Markus cannot anticipate these claims under 35 U.S.C. § 102. And to the extent that Markus cannot anticipate the independent claims, it cannot anticipate any claim that depends upon them.

E. Conclusion

The Examiner appears to have improperly construed terms in the Applicant's claims, or perhaps not considered them at all. In either event, though, the reference that the Examiner cites does not anticipate the Applicant's claimed invention when the terms therein are given their proper meaning.

Accordingly, the Applicant submits the Examiner's rejections were in error and respectfully requests reconsideration. Moreover, the Applicant believes that the claims of the

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present application are not fairly taught by any of the references of record, taken either alone or in combination. Therefore, allowance of the present application is in order, and is requested.

Respectfully submitted,



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